REMARKS

This Application has been carefully reviewed in light of the Office Action electronically sent January 25, 2007. Claims 1-35 are pending and rejected in the application. Applicants submit that the pending claims are patentably distinguishable over the cited references for the reasons given below. Applicants, therefore, respectfully request reconsideration and favorable action in this case.

Section 112 Rejections

The Examiner rejects Claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of which applicant regards as the invention. Applicants have amended Claim 11 to depend from Claim 9 instead of Claim 1, as suggested by the Examiner. Similarly changes have been made to Claims 21, 22, 32 and 33. Favorable action is respectfully requested.

Section 101 Rejections

The Examiner rejects Claims 1-11 and 23-34 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. More specifically, the Office Action asserts that independent Claims 1 and 34 recite an abstract idea and that the claimed steps amount to "only thoughts." Furthermore, the Office Action states that there is no useful, concrete and tangible result of these claims. Similarly, regarding independent Claim 23, the Office Action states that there is no useful, concrete and tangible result.

The patent laws define patentable subject matter as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto." *See* 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T*

Corp. v. Excel Comm. Inc., 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

"Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., "[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete, and tangible result' -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601-02; M.P.E.P. § 2106.

Applicants' claims are not merely manipulations of abstract ideas. Instead, each of Applicants' claims clearly recites a useful, concrete, and tangible result, which is all the law requires for a claim to be directed to statutory subject matter, and is therefore directed to patentable subject matter. For example, independent Claim 1 recites "determining service parameters for [a] telecommunications service" and "establishing the telecommunications service based on the service parameters." Thus, determining service parameters so that a telecommunication service can be established is one practical application of independent Claim 1, the useful, concrete, and tangible result being determined service parameters and an established telecommunications service. The other claims of the present application have a similar practical application and utility.

For at least the foregoing reasons, Applicant respectfully submits that 1-11 and 23-34 recite statutory subject matter and claim inventions that have patentable utility. Therefore, Applicant respectfully requests reconsideration and allowance of Claims 1-11 and 23-34.

Section 102 Rejections

The Examiner rejects Claims 1-34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,771,381 issued to Jones et al. ("*Jones*").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P § 2131 (*emphasis added*).

Claim 1 of the Application, as amended, recites the following limitations:

A method for provisioning a network element, comprising:
providing a custom default file and a standard default file in a network element, the custom default file comprising one or more default parameters of a same type as, but having a different value from, corresponding default parameters in the standard default file, wherein the default parameters are associated with commands used to provision the network element for a telecommunications service;
determining service parameters for the telecommunications service based on default parameters of the standard default file as modified by overriding default parameters of the custom default file; and
establishing the telecommunications service based on the service parameters.

Independent Claims 12, 23, and 34 recite similar, although not identical, limitations.

Independent Claim 1 (as well as independent Claims 12, 23, and 34) is allowable because *Jones* does not disclose each and every one of these limitations. For example, *Jones* does not disclose standard and custom default files that include "default parameters [that] are associated with commands used to provision the network element for a telecommunications service." Furthermore, *Jones* does not disclose "determining service parameters for the

telecommunications service" or "establishing the telecommunications service based on the service parameters." Instead *Jones* addresses the creation of configuration files for configuring a computer for use by a particular user. The configuration files do not include default parameters that are associated with commands used to provision the network element for a telecommunications service. Furthermore, the files are not used to determine service parameters for a telecommunications service or to establish the telecommunications service.

For at least the reasons provided above, Applicants believe that Claim 1 is in condition for allowance. In addition, independent Claims 12, 23, and 34 recite similar, although not identical, limitations to those discussed above. Thus, Applicants believe that these claims are also in condition for allowance. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1, 12, 23, and 34, as well as the claims that depend from these independent claims.

In addition to being allowable as depending from one of independent Claims 1, 12, and 23, many of the dependent claims are further allowable because *Jones* does not disclose the additional limitations taught by these claims. As an example only, Claim 9 recites that "the custom default file comprises default parameters of a type selected from a group consisting of threshold driven parameters and non-threshold parameters." Claims 20 and 31 recite similar limitations. For a teaching of this limitation, the Office Action refers to Figure 7 and Column 8, lines 35-55 of *Jones*. However, Applicants cannot see, and the Office Action does not explain, how this passage and figure disclose the recited limitation. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 9, 20 and 31.

As another example, Claim 10 further recites that the threshold driven parameters recited in Claim 9 comprise a set of thresholds for a plurality of communication types. Claims 21 and 32 recite similar limitations. For a teaching of this limitation, the Office Action again refers to Figure 7 and Column 8, lines 35-55 of *Jones*. However, Applicants cannot see, and the Office Action does not explain, how this passage and figure disclose the recited limitation. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 10, 21 and 32.

Furthermore, Claim 11 recites that the non-threshold parameters recited in Claim 9 comprise parameters associated with a category selected from a group consisting of allow and inhibit monitoring category, allow and inhibit COMM monitoring category, initialize monitoring category, set threshold T1 clock category, edit system category, enter ethernet category, edit ethernet category, enter clock category, and edit clock category. Independent Claim 35 and dependent Claims 22 and 33 recite similar limitations. For a teaching of this limitation, the Office Action refers to Column 5, lines 16-32 of *Jones*, explaining that this passage discloses that a choice by the user to edit and customize the system is provided. However, this passage does not disclose any of the specific parameter categories recited in these claims. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 11, 22, 33 and 35.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicants hereby request a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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